

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Stephen Almeida
Title: Multiple Pulse Photo-Epilator
Serial No.: 09/173,422
Filing Date: October 15, 1998
Patent No.: 6,228,074
Issue Date: May 8, 2001

PETITION FOR RECONSIDERATION UNDER 37 C.F.R. § 1.378(e)

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition under 37 C.F.R. § 1.378(e) for reconsideration of Examiner's Decision on Petition, dated March 21, 2012, on Patentee's Petition to accept the delayed payment of maintenance fees due on the above-identified patent, on an expedited basis, whereby the patent will not be considered as having been expired. This request for reconsideration is filed on behalf of Stephen Almeida, who is the inventor of U.S. Patent No. 6,228,074, the above-identified patent (the Petition Patent).

Patent No. 6,228,074 was issued on May 8, 2001. The first maintenance fee was paid in accordance with the provisions of 37 C.F.R. § 1.362(e)(1). The second maintenance fee could have been paid with the surcharge set forth in 37 CFR 1.362(e)(3) as late as June 8, 2009. Since the second maintenance fee was not paid, Patent No. 6,228,074 expired after midnight on June 8, 2009.

A petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken

to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The Office of Petitions in its Decision On Petition (“Decision”) acknowledged receipt of the payment of the petition fee of \$400.00. Previously, the required maintenance fee of \$1,425.00 and the surcharge set forth in 37 C.F.R. § 1.20(i)(1) was acknowledged and charged to counsel’s deposit account. This petition for reconsideration is accompanied by a petition fee of \$400.00 as set forth in 37 C.F.R. § 1.17(f).

DECISION ON PETITION

The Patent Office held that the showing of record was inadequate to establish unavoidable delay. The Patent Office stated that the Petition was lacking in that the Petitioner had not provided affidavits or statements of facts from Deborah Hopkins and Betty McCorkle setting forth the facts as they know them. The Patent Office dismissed Petitioner’s petition and stated that the Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work to assure proper execution of assigned tasks.

The Examiner in his Decision also suggested that the Petition Patent was not docketed for payment of the second maintenance fee at Brown Rudnick, in that no docket records for the subject patent were among those transferred to Seyfarth Shaw. The Examiner states “if the patent was never entered into the Brown Rudnick database, it appears it would not have been docketed at Seyfarth Shaw, and therefore would not have been docketed at all for tracking and payment of the second maintenance fee.

SHOWING OF UNAVOIDABLE DELAY

The Petitioner, mindful of the Examiner’s request for information from Deborah Hopkins and Betty McCorkle, sought a statement of facts concerning their involvement with the Brown Rudnick to Seyfarth Shaw file transfer (Transfer). Despite effort by Mark Leonardo, of Brown Rudnick, as evidenced by attached emails, Brown Rudnick was unable to timely obtain a Declaration from Deborah Hopkins outlining her involvement in the transfer as requested in the Decision. Ms Hopkins is no longer employed by Brown Rudnick, but moved on to a similar position at another large Boston law firm. The Petitioner respectfully submits that the Declaration of Shultz, which was previously submitted, identifies him as the project manager of this transfer and also the person most closely associated with the clerical error resulting in the inadvertent failure to comply with the client’s transfer request and that a Declaration from Hopkins would add nothing further to the record. The Petitioner has attached a Supplemental Declaration of June Kaps (Exhibit G), of Seyfarth Shaw and formerly of Brown Rudnick, at all times relevant to the docketing of the Petition Patent, to supplement the previously submitted declarations of Stephen Almeida (Exhibit A), June Kaps (Exhibit B), Edwin Colon (Exhibit C), John Serio (Exhibit D), Mark S. Leonardo (Exhibit E), and Keith Schultz (Exhibit F), Petitioner

has attached to this petition the previously submitted declarations and attachments for the convenience of the Examiner.

This additional Declaration, when taken with the previously submitted Declarations and attachments, clearly establishes that Brown Rudnick, the law firm that prosecuted the application from which the above-identified patent matured had docketed all maintenance fees due (i.e. 3.5 years; 7.5 years and 11.5 years). Brown Rudnick without incident paid the first maintenance fee due. Brown Rudnick had received instructions to transfer the files associated with the Petition Patent to Seyfarth Shaw. Brown Rudnick, because of inadvertent clerical error in the transfer of docketing information that was identified by the Declaration of Keith Shultz, unavoidably failed to transfer at least the requested electronic docketing information to Seyfarth Shaw that has a reliable docket system to ensure timely payment of maintenance fees. The previously filed Declaration of Keith Schultz fully sets forth the circumstance causing a clerical error that caused a transfer error. The inadvertent docketing information transfer error and corresponding failure to transfer relevant physical files caused the docket records at Seyfarth Shaw to not reflect the maintenance fees that were due for the Petition Patent as they were at Brown Rudnick prior to the transfer. As a result of the clerical error, which caused a docketing information transfer error, docketing information was not received by Seyfarth Shaw causing the matter of the Petition Patent to not be entered in Seyfarth Shaw's docketing system and the correspondence address to not be updated at the Patent Office.

The Petitioner respectfully suggests that the requested Declaration of Deborah Hopkins would not add to the record, as she oversaw the high level operation of the file room and did not engage in the day to day activities, such as the Transfer, which was handled by Schultz. The record in this Petition to Revive is now complete as to all of the relevant facts, as the Patent

Office has requested, and clearly reflects that Brown Rudnick inadvertently failed to transfer, due to a clerical error as attested to by Keith Shultz (See Exhibit F), at least the electronic docketing information to Seyfarth Shaw, despite written instructions from the client. The record further reflects that all maintenance fees that were due for the Petition Patent were docketed by the relevant docketing clerk upon the issuance of the Petition Patent, as attested to by June Kaps in her Supplemental Declaration (See Exhibit G).

As Petitioner has previously established, it is respectfully submitted that Seyfarth Shaw also did not receive the client requested physical files as established by the previously submitted declarations of Serio, Kaps and Colon. The file transfer protocol in place that was developed by experienced patent practitioners and Kaps, an experienced patent docketing clerk with over 17 years of experience, was dependant upon the receipt of at least a physical file and/or its corresponding electronic docketing information.

In developing Seyfarth's file transfer protocol, redundant transfer of both physical and electronic docketing information was aimed at ensuring that transfer errors would be reasonably avoided, however, since it was dependant upon humans, no protocol would be absolutely fail safe and therefore some errors are "unavoidable," as is acknowledge by the Patent Office in providing for the within petition rights. The file transfer protocol developed by Seyfarth was reasonably based upon a system that accounted for failures in transfer of either the physical file or the docketing information.

The Supplemental Declaration of Kaps along with the previously submitted declarations and the Patent Maintenance Fee records at the United States Patent and Trademark Office (USPTO) establish the unavoidable nature of the failure to pay the maintenance fee for the Petition Patent.

More specifically:

1. Shortly after receipt of the Decision on Petition, Serio contacted Mark Leonardo of Brown Rudnick seeking additional declarations requested by the Examiner, namely Declarations from Hopkins and McCorkle. Investigation revealed that McCorkle, who is no longer employed by Brown Rudnick, only assisted in a secretarial role and did not assist in the systems and procedures for the Transfer. Despite diligent effort by Leonardo, Hopkins being no longer employed by Brown Rudnick and for her own reasons could not timely cooperate in executing a Declaration regarding the facts of the Transfer.
2. It has been clearly established during this petition process, that both Brown Rudnick and Seyfarth Shaw have a complete and reliable system for docketing deadlines pertaining to USPTO proceedings, including deadlines for payment of maintenance fees. Both of these firms are large International Law Firms having well developed docketing systems using best practices within the patent profession. Both patent docketing systems include a well known patent docketing software program from Computer Packages Inc. called “CPI” (Kaps Decl. ¶10; Kaps Supp Decl. ¶10; Leonardo Decl. ¶26). This state of the art software program used by both firms, calculates future deadlines from information entered into the program and produces reminders of those deadlines. Information entered into the program populates all future action items during the life of an issued patent.
3. It has also been clearly established that during the transfer of physical and electronic files from Brown Rudnick to Seyfarth Shaw, Seyfarth Shaw contracted with CPI, who worked with both Brown Rudnick and Seyfarth Shaw, to retrieve all electronic docketing information related to all clients that requested transfer of their files from Brown Rudnick to Seyfarth Shaw.

The list of docket information to be transferred was populated by Brown Rudnick based upon ongoing client requested transfers. (Kaps Decl., ¶¶14–16; Schultz Decl. ¶11).

4. The transfer of over 700 active files and several thousand inactive files was coordinated between the docketing and file room personnel of both Seyfarth Shaw and Brown Rudnick. Both departments engaged experienced personnel to carry out these functions. To ensure redundancy and best practices for the transfer of numerous clients from Brown Rudnick to Seyfarth Shaw, Seyfarth Shaw's docketing clerk June Kaps, who has extensive experience in docketing matters, (Kaps Decl., ¶¶5–7) worked with experienced personnel within the file room of Brown Rudnick (Schultz Decl. ¶6-9; Leonardo Decl. ¶ 11-13).

5. Keith Shultz having appropriate education and experience, was entrusted with the day-to-day operations of the Transfer including matters involving IT issues. Shultz has extensive IT experience and a degree in Computer Technology. Because of Mr. Shultz's background in Information Technology (IT) and his extensive work experience in IT matters, he continues to be responsible for all matters concerning electronic records and databases involving client files at Brown Rudnick; (See Leonardo Decl. ¶11;).

6. Betty McCorkle, who handled secretarial functions related to this transfer, was not involved in decision making or management of this transfer. McCorkle had no management responsibility or knowledge of the file transfer error. (See Leonardo Decl. ¶11;)

7. Ms. Kaps, who is currently the docketing administrator for Seyfarth Shaw, was previously the docketing administrator for Brown Rudnick at all times relevant to the docketing of the maintenance fees for the Petition Patent on behalf of Brown Rudnick. As set forth Ms. Kaps' Supplemental Declaration, while employed by Brown Rudnick she docketed all maintenance fees for the Petition Patent, upon the issuance of the Petition Patent. Had the client

transfer request been complied without incident, the docketing information for the Petition Patent would have been had transferred to Seyfarth Shaw's docketing system during the CPI data dump and confirmed during the physical file transfer. (Kaps Supplemental Decl., ¶ 11-12).

8. As attested to by June Kaps, who was Brown Rudnick's docketing clerk at the time of issuance of the Petition Patent, was responsible for and properly completed the docketing of maintenance of the Petition Patent, within Brown Rudnick's docket system that reflected the due dates for all future maintenance fees for the Petition Patent, namely the maintenance fees for 3.5 years, 7.5 years and 11.5 years Brown Rudnick timely paid the 3.5 year maintenance fee for the Petition Patent based upon Kaps' docketing function. (See Kaps Supplemental Decl., ¶ 12-13)

9. The record is clear, that the Petition Patent was properly docketed by Brown Rudnick, which had a reliable state of the art docketing system. The failure to pay the Petition Patent's second maintenance fees was caused by an unavoidable clerical error during the transfer of files between Brown Rudnick and Seyfarth Shaw. (Kaps Supplemental Decl., ¶ 11-12; Schultz Decl. ¶11).

10. Brown Rudnick and Seyfarth Shaw believed that the steps taken during the transfer of files had redundancy to ensure that important client matters would be protected in the form of the transfer and receipt of physical files, but also the transfer and receipt of corresponding electronic docket entries. These procedures resulted in the successful transfer of over 700 active files and several thousand non-active patent files without incident, but for the Petition Patent and Expired Patent. (See Kaps Decl., ¶15) (See Leonardo Decl. ¶15).

11. The additional Supplemental Declaration of Kaps, along with previously submitted Declarations, clearly establish a record that shows as a result of Brown Rudnick's investigation, that Brown Rudnick determined that they received a reminder notice from the USPTO

concerning the Expired Patent, and they believed that they received a reminder notice from the USPTO concerning the Petition Patent. Brown Rudnick believed that both expiration notices received by them were forwarded to Seyfarth, as is Brown Rudnick's customary practice, however, they only have evidence of transmittal of the second notice concerning the Expired Patent and have no record of forwarding the reminder notices for the Petition Patent; (See Exhibit E, Leonardo Declaration ¶24).

12. The record is also clear that as a further result of Brown Rudnick's investigation, Brown Rudnick confirmed making arrangements to have the client docket entries on the CPI system for the Expired Patent and Petition Patent transferred to Seyfarth, but in doing so, the transfer only effected a transfer of selected files (Matters 7&9: non-patent matters) other than the Expired Patent and the Petition Patent. During the course of Brown Rudnick's investigation it was determined that the transferred selected files concerned non-patent matters for the client and contained no docket information regarding the Expired Patent and the Petition Patent. Brown Rudnick's investigation determined that the failure to transfer docketing information of the Petition Patent was caused solely by an inadvertent clerical error and was not in anyway related to the services of CPI (See Exhibit E, Leonardo Declaration ¶25; Shultz Declaration).

13. Further Investigation by Seyfarth Shaw clearly establishes that CPI transferred without incident several hundred files of docketing information and was found by Brown Rudnick's investigation and Seyfarth Shaw's investigation not to be the source of this file transfer error. CPI provided Seyfarth Shaw a listing of all files transferred upon instruction from Brown Rudnick. Petitioner attached a listing of CPI to its original petition. (See Kaps Declaration ¶ 25-26).

14. In summary, in view of the original Petition to Revive, the request for reconsideration filed on January 19, 2012 and the present Petition for Reconsideration, the completed record shows that Seyfarth Shaw and Brown Rudnick have reliable docket systems for ensuring timely payment of maintenance fees. As a result of a clerical error, docketing information that was believed to have been transferred by CPI to Seyfarth Shaw was not received. Brown Rudnick, mistakenly, only instructed CPI to transfer selected client matters containing non-docket information. This mistaken belief caused the required maintenance fee notices to not be processed by Brown Rudnick, and these notices were not forwarded to Seyfarth Shaw as was Brown Rudnick's customary practice. Seyfarth Shaw, not being in receipt of the physical files from Brown Rudnick or the electronic files via CPI, nor the notice sent by the Patent Office, was unaware of the need to pay these maintenance fees. Thus, the complete record shows an unavoidable delay as to non-payment of the 2nd maintenance fee.

CONCLUSION

Petitioner submits that the record is complete as requested by the Patent Office and a proper showing has been made that the delay in the payment of the maintenance fee due on this Petition Patent was unavoidable due to a clerical error resulting in the failure to transfer docketing information.

Accordingly, acceptance, on an expedited basis, of the unavoidably delayed payment of the maintenance fee due on the Petition Patent is respectfully requested, whereby the patent will not be considered as having been expired.

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No. 50-2896.

Respectfully submitted,

May 21, 2012
Date:

/John C. Serio/
John C. Serio, Reg. No. 39,023
Attorney for Patentee
Seyfarth Shaw LLP
Two Seaport Lane, Suite 300
Boston, MA 02210-2028
Tel.: (617) 946-4831
Fax: (617) 946-4801

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

/Seema S. White/
Seema S. White

May 21, 2012
Date: